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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,546	04/03/2006	Saar Wilf	2043.560US1	4073
49845 7590 07/13/2010 SCHWEGMAN, LUNDBERG & WOESSNER/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER NIGH, JAMES D	
			ART UNIT 3685	PAPER NUMBER
			NOTIFICATION DATE 07/13/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/574,546	Applicant(s) WILF ET AL.	
	Examiner JAMES D. NIGH	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7 and 9-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7 and 9-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>16 April 2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendments and remarks filed on 2 June 2010.

Claim Status

2. Claims 16 and 21 have been amended. Claims 4 and 8 were previously cancelled. Claims 1-3, 5-7 and 9-22 are currently pending and are presented for examination on the merits.

Information Disclosure Statement

3. The information disclosure statement (IDS) was submitted on 16 April 2010. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

4. Applicant's argument with regard to the 35 U.S.C. § 101 rejection of claims 1-3, 5-7 and 9-15 has been fully considered and is persuasive. Accordingly the rejection will be withdrawn.

5. Applicant's argument with regard to the 35 U.S.C. § 103 (a) rejection of claims 1-3, 5-7, 9 and 11-22 have been fully considered but is not persuasive. Examiner respectfully disagrees with Applicant that all elements were not considered. As pointed out in the prior office action, the data used in the matching process cannot be used to distinguish the claimed invention from the prior art as this is simply non-functional descriptive material as the same results would be achieved with Hillmer "Where the printed matter is not functionally related to the substrate, the printed matter will not

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distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate” *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II. Applicant’s process recites “usable to verify” which is not a method step and is therefore not entitled to patentable weight as it is merely a description of the nature of the data. Applicant’s disclosure at the very least indicates that verifying and matching are synonymous (page 8, “this comparison between candidate and stored personal details is carried out by seeking a literal match”, page 12, “Optional Comparison Module 34 compares candidate and stored personal details to determine whether they match, as described above”) therefore to equate verifying and matching is reasonable in light of the specification, particularly as no other form of verifying is taught by the specification. Applicant’s assertion that “matching the stored personal detail to the candidate personal detail” is not part of the claim is not germane here to the determination of patentability as it is the manner of verifying taught by Applicant’s disclosure (in this case “matching”) that is relevant. Examiner has completely reviewed Applicant’s disclosure and finds no other mechanism for “verifying” other than “matching”. Moreover Hillmer discloses basing decisions on time (10:38-48), identification procedures (5:59-6:20, 6:37-65, 9:21-55) and degree of personal exposure (7:55-8:22). Therefore Hillmer teaches all of the claimed elements.

6. Applicant also argues that “Hillmer...detects fraudulent transactions” and that this is not the same as a reliability indicator. Examiner respectfully disagrees as the term

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“reliability indicator” is extremely broad; moreover as defined in the claim, “reliability indicator” only requires the ability to either know the time that the detail regarding an account was received, retrieving a record regarding an identification procedure (broadly interpreted), or retrieving a record that (broadly interpreted) involves personal exposure. Again as Hillmer discloses elements that meet the broadest reasonable interpretation of all three of these claimed limitations Hillmer satisfies the invention as claimed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5-7, 9 and 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillmer et al. (U.S. Patent 6,714,918, hereinafter referred to as Hillmer).

9. As per claim 1

Hillmer discloses receiving the account identifier (4:38-51, 6:37-65)

Hillmer discloses determining a reliability indicator (Abstract, 2:23-60)

Hillmer discloses providing a reliability indicator (7:42-53, 9:21-10:3, 10:49-58, 12:25-49)

Hillmer does not explicitly disclose “the reliability indicator determined based on at least one of a time the at least one stored personal detail was received and associated with the account identifier, record of an identification procedure performed

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upon receipt of the at least one stored personal detail, or a record of a degree of personal exposure of an entity submitting the at least one stored personal detail, the at least one stored personal detail retrieved from an account database”. However Examiner notes that in Applicant’s disclosure the only recitation that is enabled recites that the determination is performed by matching the stored personal detail to the candidate personal detail (page 8, “this comparison between candidate and stored personal details is carried out by seeking a literal match”, page 12, “Optional Comparison Module 34 compares candidate and stored personal details to determine whether they match, as described above”) and as Hillmer discloses matching (12:39-41), the data used in the matching process cannot be used to distinguish the claimed invention from the prior art as this is simply non-functional descriptive material as the same results would be achieved with Hillmer “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate” *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II

10. As per claim 2

Hillmer discloses providing stored personal details (7:7-28, 7:42-53, 12:25-49)

11. As per claim 3

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Hillmer discloses comparing a candidate detail against a stored detail (12:25-49, 13:37-48)

12. As per claim 5

Hillmer discloses recording the date of the transaction (9:21-35) and date periods factoring into the reliability (10:38-40).

13. As per claim 6

Hillmer discloses information about the transaction medium (6:66-7:6, 7:54-8:6, Table 1.0) and personal exposure (6:46-51).

14. As per claim 7

Hillmer discloses a connection over the Internet (6:66-7:6)

15. As per claim 9

Hillmer discloses an identification procedure (4:52-5:2, 6:37-65)

16. As per claim 11

Hillmer discloses carrying out fraud prevention measures based upon provided said at least one determined reliability indicator (9:21-10:22)

17. As per claim 12

Hillmer discloses wherein said fraud preventing measures are selected from the group consisting of making a phone call to a verified phone number, sending an email to a verified email address, and physically sending an item to a verified street address (9:21-10:22).

18. As per claim 13

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Hillmer discloses authorizing or denying a transaction based upon provided said at least one determined reliability indicator (5:3-38, 8:23-43, 12:14-49, 14:49-65)

19. As per claim 14

Hillmer discloses wherein said at least one stored personal detail is selected from the group consisting of account owner's name, a street address, a billing address, an additional address, a phone number, an email address, a government-issued identifier, a mother's maiden name, a social security number (9:21-10:22)

20. As per claim 15

Hillmer discloses combining a plurality of said reliability indicators to obtain at least one combined reliability indicator (9:21-10:22).

21. As per claim 16

Hillmer discloses a data receiving unit configured to receive data selected from the group consisting of the account identifier and at least one candidate personal detail (4:38-51, 6:37-65)

Hillmer discloses determining a reliability indicator (Abstract, 2:23-60)

Hillmer discloses providing a reliability indicator (7:42-53, 9:21-10:3, 10:49-58, 12:25-49).

Hillmer does not explicitly disclose "the reliability indicator determined based on at least one of a time the at least one stored personal detail was received and associated with the account identifier, record of an identification procedure performed upon receipt of the at least one stored personal detail, or a record of a degree of personal exposure of an entity submitting the at least one stored personal detail, the at

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least one stored personal detail retrieved from an account database”. However Examiner notes that in Applicant’s disclosure the only recitation that is enabled recites that the determination is performed by matching the stored personal detail to the candidate personal detail (page 8, “this comparison between candidate and stored personal details is carried out by seeking a literal match”, page 12, “Optional Comparison Module 34 compares candidate and stored personal details to determine whether they match, as described above”) and as Hillmer discloses matching (12:39-41), the data used in the matching process cannot be used to distinguish the claimed invention from the prior art as this is simply non-functional descriptive material as the same results would be achieved with Hillmer “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate” *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II

22. As per claim 17

Hillmer discloses a data output unit configured to output data selected from the group consisting of said at least one reliability indicator and at least one said stored personal details (7:7-28, 7:42-53, 12:25-49).

23. As per claim 18

Hillmer discloses a chargeable account database for storing data selected from the group consisting of at least one said stored personal detail, at least one candidate

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personal detail, at least one said account identifier, and at least one said reliability indicator (12:25-49, 13:37-48).

24. As per claim 19

Hillmer discloses wherein said reliability indicator provider includes a combining module for combining a plurality of said reliability indicators to produce a combined reliability indicator (9:21-10:22).

25. As per claim 20

Hillmer discloses a comparison module, for comparing at least one said candidate personal detail with at least one said stored personal detail (12:25-49, 13:37-48).

26. As per claim 21

Hillmer discloses a comparison module, for comparing at least one said candidate personal detail with at least one said stored personal detail, wherein said data output unit is further configured to send results of said comparison (12:25-49, 13:37-48).

27. As per claim 22

Hillmer discloses authorizing or denying a transaction based upon provided said at least one determined reliability indicator (5:3-38, 8:23-43, 12:14-49, 14:49-65).

28. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hillmer in view of Houvener et al. (U.S. Patent 6,070,141, hereinafter referred to as Houvener).

29. As per claim 10

Hillmer does not explicitly disclose wherein said verifying item is selected from the group consisting of government issued identification, a hand signature and biometric information. Houvener teaches IDs, signatures and biometric information (6:52-67, 9:16-38)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for detecting fraudulent transactions of Hillmer with the system and method of assessing the quality of an identification transaction using an identification quality score of Houvener for the purpose of identifying transactions where heightened scrutiny is warranted.

Please note:

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”).

Conclusion

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Friday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES D NIGH/
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685